



STIC Search Report

EIC 3700

STIC Database Tracking Number: 154130

TO: Andres Kashnikow
Location: RND 8a29
Art Unit: 3700
Monday, May 23, 2005

Case Serial Number: 10/797934

From: Terry Solomon
Location: EIC 3700
RND 8b31
Phone: 272-4240

terrance.solomon@uspto.gov

Search Notes

Litigation found involving US pat. 6530162. See attached documents for details.

Sources:

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SEARCH REQUEST FORM

Scientific and Technical Information Center

Requester's Full Name: ANDY KASHNIKOW Examiner #: 60484 Date: 5/22/05
Art Unit: 3700 Phone Number 302-4361 Serial Number: 101797,934
Mail Box and Bldg/Room Location: ENV-8A29 Results Format Preferred (circle): PAPER DISK E-MAIL

If more than one search is submitted, please prioritize searches in order of need.

Please provide a detailed statement of the search topic, and describe as specifically as possible the subject matter to be searched. Include the elected species or structures, keywords, synonyms, acronyms, and registry numbers, and combine with the concept or utility of the invention. Define any terms that may have a special meaning. Give examples or relevant citations, authors, etc, if known. Please attach a copy of the cover sheet, pertinent claims, and abstract.

Title of Invention: _____

Inventors (please provide full names): _____

Earliest Priority Filing Date: _____

**For Sequence Searches Only* Please include all pertinent information (parent, child, divisional, or issued patent numbers) along with the appropriate serial number.*

LIT. SEARCH FOR U.S. PATENT

6,530,162

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	Type of Search	Vendors and cost where applicable
Searcher: <u>Solomon</u>	NA Sequence (#) _____	STN _____
Searcher Phone #: <u>X24240</u>	AA Sequence (#) _____	Dialog _____
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027867 (09) 6530162 March 11, 2003

Time of Request: May 23, 2005 08:56 AM EDT

Research Information:

Utility, Design and Plant Patents
patno=6530162

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

6530162

March 11, 2003

Sports shoe cleats

REEXAM-LITIGATE:

NOTICE OF LITIGATION

Greenkeepers, Inc., et al v. Nike, Inc., et al, Filed August 6, 2004, D.C. E.D. Pennsylvania, Doc. No. 04-3747

REISSUE: March 11, 2004 - Reissue Application filed Ex. Gp.: 3728; Re. S.N. 10/797,934 (O.G. June 22, 2004)

APPL-NO: 027867 (09)

FILED-DATE: February 23, 1998

GRANTED-DATE: March 11, 2003

ASSIGNEE-AT-ISSUE: Green Keepers, Inc., Warminster, Pennsylvania, 02

ASSIGNEE-AFTER-ISSUE: August 20, 2003 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., GREENKEEPERS OF DELAWARE, LLC 103 FOULK ROAD SUITE 202 WILMINGTON DELAWARE 19803, Reel and Frame Number: 14409/0389

LEGAL-REP: Zegeer, Jim

2004 Pat. App. LEXIS 179, *

Time of Request: May 23, 2005 08:57 AM EDT

Research Information:

Patent Cases from Federal Courts and Administrative Materials
6530162 or 6,530,162

FRANCIS C. CARROLL, Junior Party (Patent Nos. 5,794,367 and 6,530,162) v. FARIS
W. McMULLIN, Senior Party (Application 09/246,325)

Patent Interference No. 105,146

BOARD OF PATENT APPEALS AND INTERFERENCES

2004 Pat. App. LEXIS 179

September 13, 2004, Faxed

[*1]

Before FLEMING, LEE and MEDLEY, Administrative Patent Judges.

COUNSEL:

For junior party Carroll:
202-572-8398 (Fax)
Victor M. Wigman, Esq.
Blank Rome LLP
Watergate 600, 11th Floor,
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037-2485

For senior party McMullin:
312-554-3301 (Fax)
Keith V. Rockey, Esq.
Wallenstein, Wagner & Rockey, Ltd.
311 South Wacker Drive
53rd Floor
Chicago, Illinois 60606-6630

OPINIONBY: LEE

OPINION:

The opinion in support of the decision being entered today is not binding precedent of the Board.

LEE, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTIONS

INTRODUCTION

This interference was declared on September 15, 2003. Both parties have filed preliminary motions. Oral argument on preliminary motions was held on August 12, 2004. We grant junior party Carroll's Preliminary Motion 2 for judgment against all of senior party McMullin's involved application claims 61-81 on the ground of 35 U.S.C. § 112,

first paragraph, for lack of written description in the specification, and hold that party McMullin is without standing to contest priority and to attack the patentability of party Carroll's involved claims.

FINDINGS

At least a preponderance [*2] of the evidence in the record supports the enumerated findings below as well as those findings contained in the discussion portion of this decision.

1. Junior party FRANCIS C. CARROLL is involved on the basis of Patent Nos. 5,794,367 and 6,530,162. Patent No. 5,794,367 is based on Application 08/802,908, filed February 20, 1997. Patent No. 6,530,162 is based on Application 09/027,857, filed February 23, 1998. With respect to Patent No. 6,530,162, the junior party is accorded the benefit of Application 08/802,908, filed February 20, 1997.

2. Senior party FARIS W. McMULLIN is involved on the basis of Application No. 09/246,325, filed September 2, 1999. Senior party McMullin is accorded the benefit of Application 09/209,252, filed December 10, 1998, Application 08/823,901, filed March 2, 1997, and Provisional Application 60/034,328, filed December 20, 1996.

3. The real party in interest of the junior party's involved patents is Greenkeepers of Delaware, LLC. (Paper No. 4)

4. The real party in interest of the senior party's involved application is Softspikes, LLC. (Paper No. 8)

5. The count of this interference, as re-declared on November 7, 2003 (Paper No. 16), is Claim 81 of McMullin's [*3] involved Application 09/246,325 or claim 10 of Carroll's involved Patent No. 6,530,162. (Paper No. 16)

6. The claims of the parties which correspond to the count are claims 1-16 of Carroll's involved Patent No. 5,794,367, claims 1-11 of Carroll's involved Patent No. 6,530,162, and claims 61-81 of McMullin's involved Application 09/246,325. (Paper No. 16)

7. None of McMullin's involved claims 61-81 is an original claim included in McMullin's involved Application 09/246,325 as filed on September 2, 1999. They were all added to the application subsequent to the application's filing date.

DISCUSSION

Carroll's Preliminary Motion 2

Carroll's Preliminary Motion 2 attacks all of McMullin's claims corresponding to the count, i.e., application claims 61-81, under 35 U.S.C. § 112, first paragraph, as being without written description in the specification. All of McMullin's claims 61-81 were added subsequent to the filing of McMullin's involved application and thus cannot provide their own written description for satisfying the written description requirement of 35 U.S.C. § 112, first paragraph.

As the moving party, [*4] Carroll bears the burden of proof to show that he is entitled to the relief sought. 37 CFR § 1.637(a). On the question of the written description requirement under 35 U.S.C. § 112, first paragraph, the issue is whether the specification reasonably conveys to the artisan that the inventor had possession at the earlier time of the later claimed subject matter. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). The specification must convey with reasonable clarity to those with ordinary skill in the art that, as of the filing date of the application, the inventor was in possession of the invention now claimed. See, e.g., *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117, (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Smythe*, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973); *In re Anderson*, 471 F.2d 1237, 1240, 176 USPQ 331, 333 (CCPA 1973). [*5]

Each of McMullin's claims 61-81 is directed either to a golf shoe cleat or a golf shoe including golf shoe cleats wherein the cleat comprises a plurality of traction teeth. Every claim includes a specific feature about the general orientation of each traction tooth.

Claim 61 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 62 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction" Claim 62 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 63 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 64 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction" Claim 64 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 65 recites: [*6] "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 66 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction through the plane of a golf swing." Claim 66 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 67 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 68 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction through the plane of a golf swing." Claim 68 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 69 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 70 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative [*7] to said stud axis to provide lateral stability and enhanced traction through the plane of a golf swing." Claim 70 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 71 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 72 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction through the plane of a golf swing." Claim 72 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 73 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 74 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction through the plane of a golf swing." Claim 74 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the [*8] main body member.

Claim 75 recites: "each tooth having an outward angle to provide lateral stability and traction through the plane of a golf swing."

Claim 76 recites: "each perimeter traction tooth having a tooth axis which is at an outward angulation relative to said stud axis to provide lateral stability and enhanced traction through the plane of a golf swing." Claim 76 includes a stud extending from a main body member and projecting vertically outwardly from an inner face of the main body member.

Claim 77 recites: "each traction tooth having a second axis and each second axis having an outward angulation relative to said first axis to provide lateral stability and enhanced traction through the plane of a golf swing." The golf shoe cleat of claim 77 includes a body member with an inner face and a shoe mounting member having a first axis perpendicular to the inner face and projecting outwardly from the inner face.

Claim 78 recites: "each traction tooth having a second axis and an outwardly angled outer traction surface which faces away from said first axis to provide lateral stability and traction through the plane of a golf swing." The golf shoe

cleat of claim 78 includes a body [*9] member with an inner face and a mounting member projecting vertically outwardly from the inner face and having a first axis.

Claim 79 depends from claim 78 and thus includes all the features of claim 78.

Claim 80 recites: "each traction tooth having a second axis and outer traction surface which are angled away from said first axis, said outer traction surface having an outward angulation relative to said first axis to provide lateral stability and enhanced traction through the plane of a golf swing." The golf shoe cleat of claim 80 includes a body member with an inner face and a shoe attaching member having a first axis and projecting perpendicularly outwardly from said inner face.

Claim 81 recites: "each traction tooth having an outer traction surface facing away from said first axis, said outer surface having an outward angulation relative to said first axis to enhance lateral stability and traction through the plane of a golf swing. The golf shoe cleat of claim 81 includes a body member with an inner face and a shoe attaching member having a first axis and projecting perpendicularly outwardly from said inner face.

According to the text of McMullin's claims quoted above, each traction [*10] tooth of the golf shoe cleat or the outer traction surface of each traction tooth must have an outward angulation or angle. The outward angulation or angle is generally recited, without any range restriction. Any outward angle is covered by the claim recitation. The traction tooth or its outer traction surface can be from near-vertical with almost 0 [degree] outward angulation to near-horizontal with an almost 90 [degrees] outward angulation and still is within the scope of McMullin's claims. In McMullin's claims 61-81, the idea of the angular orientation of each traction tooth or outer traction surface of each traction tooth is broad.

There is no dispute between the parties with regard to how the claimed angulation is measured, i.e., relative to the "normal" axis perpendicular to the plane of contact between each cleat and the bottom surface of the shoe. As is described in McMullin's specification, for each cleat there is a flange that carries all the traction teeth and from which each traction tooth extends (McMullin Spec. at page 8, line 19 and at page 9, lines 18-19; Exhibit 2002). The edge of the flange touches the shoe bottom and can be of any shape so long as the entire edge [*11] lies in one plane (McMullin Spec. at pp. 8-9; Exhibit 2002). In short, the angle is measured with respect to an axis that is normal or perpendicular to the plane of engagement or contact between the cleat and the shoe. To illustrate such an angle, Figure 6 of McMullin's involved application is reproduced below, wherein numeral 63 identifies the axis normal or perpendicular to the plane of engagement between the cleat and the shoe, numeral 61 identifies the line of extension of the traction tooth or its outer surface, and numeral 64 identifies the angle therebetween:

[See Formula in Original]

Carroll has established by a preponderance of the evidence that the specification of McMullin's application as filed on September 2, 1999 does not reasonably convey to one with ordinary skill in the art that McMullin possessed, on that filing date in contrast to when claims 61-81 were subsequently added, the idea that each traction tooth or an outer traction surface thereof has an outward angle or angulation that is not limited to a particular range or subset of angles.

As is pointed out by Carroll (Motion at page 8, lines 9-10), McMullin's specification as filed on September 2, 1999, prescribes [*12] a limitation for the outward angulation. Carroll's argument is that McMullin's specification contains no indication that the idea of an unrestricted outward angle or angulation, included in claims 61-81 now at issue, was contemplated or possessed by Faris W. McMullin, the named inventor, at the time of filing of McMullin's involved application. With regard to the angulation of the traction tooth, McMullin's specification states the following (McMullin Spec. at page 10, lines 1-5; Exhibit 2002):

Each traction protrusion has an axis, which extends from the flange at an angle, measured relative to a normal to the plane defined by the edge, between about 5 [degrees] inward from the edge to about 15 [degrees] outward from the edge.

Furthermore, as is illustrated in McMullin's Figure 6, angle 64 is described as extending "outward from a normal 63 to the plane of edge 43 by an angle 64 of up to about 15 [degrees] as shown" (McMullin Spec. at page 11, lines 15-16; Exhibit 2002) (see also Figure 6 reproduced on previous page). There is no indication whatsoever in McMullin's specification as filed on September 2, 1999, that inventor Faris W. McMullin contemplated that the angle 64 shown [*13] in Figure 6 can be greater than 15 [degrees] in the context of McMullin's invention. Each time the angle is discussed it is identified with a range restriction limiting it to no more than about 15 [degrees].

At oral argument on August 12, 2004, the panel asked counsel for McMullin to show to the panel something in McMullin's specification that indicates that the inventor appreciated that the outward angle can be something not limited to the limited range described in the specification of McMullin's involved application. Counsel for McMullin was unable to point to any such indication in the specification. The exchange is reproduced below (Transcript at 42-43):

JUDGE LEE: Show us something in your spec that shows you appreciated an angle that's outside of the range from minus 5 to plus 15.

[Counsel for McMullin]: We didn't. We specifically identified that, but the claims aren't limited and that's where the CFMT case comes in.

JUDGE LEE: If we disagree with you on how that case is interpreted, then their [Carroll] motion should be granted?

[Counsel for McMullin]: I suppose if I'm wrong on that, that we had some obligation to say, well, we can use the same angles that they did, [*14] then I suppose that's right. But the law has never required that.

The above-quoted exchange amounts to an admission from McMullin's counsel that McMullin's involved specification does not have written description for an angle that is outside of the particular narrow range, from 5 [degrees] inward to 15 [degrees] outward, as described in the specification. What remains is essentially a purely legal question of whether 35 U.S.C. § 112, first paragraph, requires that the specification reflect that at the time of filing of the application the inventor possessed or appreciated an invention that is commensurate in scope with what has been later claimed.

We reject McMullin's argument, as expressed in McMullin's opposition to Carroll's Preliminary Motion 2, that the narrow disclosure in McMullin's specification is not a written description problem for the broadly recited claims 61-81 under 35 U.S.C. § 112, first paragraph. McMullin argues that there can be no requirement that McMullin specifically describe every single embodiment that falls within the scope of the broadly recited claims. The argument is misplaced. [*15]

Written description for an invention with a broad scope requires a description having a correspondingly broad scope and does not require a description of every possible embodiment falling within that scope. For instance, a general description that each traction tooth or an outer traction surface on each traction tooth has an outward angulation relative to the normal axis with respect to the plane of engagement between the cleat and the shoe would be sufficient written description for the claimed outward angulation or angle. It is not necessary that McMullin's specification particularly recite every possible angle. Indeed, reciting every possible angle is an impossible task, as a virtually infinite number of angles exists in a continuum of angles.

The problem with McMullin's specification as filed is that it does not reasonably convey that the inventor at the time of filing the application actually contemplated or possessed the idea that the outward angle 64 as illustrated in McMullin's Figure 6 can be greater than 15 [degrees]. Such a disclosure does not provide written description under 35 U.S.C. § 112, first paragraph, for the broad and unrestricted [*16] outward angulation or angle recited in McMullin's claims 61-81. In short, McMullin's narrow description does not support the breadth of its claims 61-81. In that connection, note *In re Wakefield*, 422 F.2d 897, 903-04, 164 USPQ 636, 641 (CCPA 1970):

A breadth rejection such as this is really an assertion that the specification is insufficient to support claims of the breadth sought. See *In re Cavallito*, 49 CCPA 1335, 306 F.2d 505, 134 USPQ 370 (1962). The proper statutory basis for such a rejection is the *first* paragraph of § 112. [Footnote omitted] (Emphasis in original)

See also *In re Wertheim*, 541 F.2d 257, 263-64, 191 USPQ 90, 97 (CCPA 1976). Does McMullin's specification reasonably convey to one with ordinary skill in the art that the invention so described includes an outward angle 64 as shown in Figure 6 that can extend beyond 15 [degrees]? The answer is no. We do not find any reference in McMullin's specification as filed to the angular orientation of the traction tooth or of an outer traction surface of each traction [*17] tooth, which is not accompanied by a range restriction of "up to about 15 [degrees]," and counsel for McMullin, when asked about the same at oral argument, could point to none.

Carroll's Preliminary Motion 2 is submitted with a declaration of Charles A. Garris, Jr. (Exhibit 2010). Upon cross-examination of Charles A. Garris, Jr., McMullin's counsel obtained the following response from Mr. Garris (Exhibit 1012, at page 43) n1:

Q. Okay. So there isn't any doubt in your mind, is there, that Mr. McMullin had at the time he filed the application for this patent, the '923 patent, had possession of a cleat with outward angulation.

A. Yeah. At the time that he filed the '923 patent, which was I guess December 10, 1998, he did have possession of a cleat [that] would have outward angulation.

According to McMullin's counsel, the above response of Mr. Garris concedes that McMullin's Figure 6 depicts the outward angulation claimed. We disagree. McMullin's counsel erroneously equates possession of a small subset of outward angulation to possession of the general idea of an outward angulation that is unrestricted to any particular range. The latter is what McMullin's specification [*18] as filed does not reasonably convey and that is not changed by or in any way inconsistent with the above-quoted cross-examination testimony of Mr. Garris. Counsel for McMullin evidently has failed to appreciate that having a description for a narrow article falling within the scope of a broad claim is not the same as having a description for the broader concept itself that is reflected in the claim.

n1 McMullin's involved application is a continuation of a parent application which issued as Patent No. 6,052,923, the '923 patent.

In any event, we have not credited the declaration testimony of Charles A. Garris, Jr. (Exhibit 2010) with much significance in supporting Carroll's Preliminary Motion 2. It is largely misdirected to why, for a variety of reasons and in the context of McMullin's specification, one with ordinary skill in the art would choose or prefer an outward angle of "up to about 15 [degrees]" over an outward angle greater than 15 [degrees], rather than to what the specification tells one with ordinary skill in the art about what inventor Faris W. McMullin possessed or appreciated. The issue here is not which one of two choices or selections makes a better or more profitable [*19] product from the perspective of one with ordinary skill in the art, but what the specification conveys to one with ordinary skill in the art about the ideas possessed by the inventor at the time of filing of McMullin's involved application.

McMullin cites as instructive *CFMT, Inc. v. Yieldup International Corp.*, 349 F.3d 1333, 1339, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003). But the case is not apposite because it pertains to the enabling disclosure requirement rather than the written description requirement of 35 U.S.C. § 112, first paragraph. In *CFMT*, the claim at issue generally required "cleaning" a wafer without reciting a particular standard or result and the specification was attacked as non-enabling for not disclosing an embodiment that can meet a particular commercial grade standard. The court held that when an invention claims a general system to improve the cleaning process for semiconductor wafers, the disclosure enables that invention by showing improvements in the overall system; no particular commercial grade cleaning standard had to be met. The issue was not the written description requirement [*20] of 35 U.S.C. § 112, first paragraph.

In any event, the claim feature underlying the issue in *CFMT* is not of the same type as that involved in this case. In *CFMT*, at issue is the degree of the functional result achieved, i.e., how effective must the disclosed cleaning process be in achieving cleanliness? In this case, at issue is not any functional result but physical structure, e.g., the traction tooth or traction surface has an outward angulation that is unrestricted in range. One is to recognize that a structural element can take on a wide variety of angles and the other is to have no special requirements for how well the claimed "cleaning" must be achieved. The elements are apples and oranges, different in kind. If anything the *CFMT* case is consistent with the concept that the disclosure should be commensurate in scope with what is claimed. In *CFMT*, the specification evidently discloses a process that achieves general cleaning improvements, which corresponds to the general recitation in the claim for cleaning a wafer. There was no mismatch in scope. Here, the description in McMullin's specification is not commensurate [*21] in scope with the claims. In *Lockwood v. American Airlines Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997), the Court of Appeals for the Federal Circuit made amply clear that under 35 U.S.C. § 112, first paragraph, one must describe the claimed invention with all its features and not just that which would render the claimed invention obvious to one with ordinary skill in the art.

At oral argument, subsequent to coming up empty in an opportunity to point out something in the specification which indicates that the inventor appreciated the general idea of an outward angulation not limited to 15 [degrees], counsel for McMullin presented a new argument which was not asserted in McMullin's opposition to Carroll's Preliminary Motion 2. Specifically, counsel for McMullin stated (Transcript at page 44):

When we show minus 5 to 15, what we are suggesting to a person skilled in the art is [that] the angle doesn't really matter.

The above-quoted statement is not only a new argument presented in far too late a stage of the proceeding that it is not entitled to consideration but also without [*22] merit even if considered. We dismiss the argument as belated. Party Carroll is without a full and meaningful opportunity to respond. Alternatively, the argument is rejected for three reasons. First, if there is any suggestion that the angle does not matter, the suggestion only pertains to the limited range between minus 5 degrees and plus 15 degrees. There is no basis whatsoever to stretch that non-distinction to the entire spectrum of outward angles without restriction. Secondly, as we discussed above and as is explained in *Lockwood v. American Airlines Inc.*, *supra*, the written description issue under 35 U.S.C. § 112, first paragraph, is about describing the claimed invention with all its features and not just that which would render the claimed invention obvious to one with ordinary skill. Third, but not least, McMullin advanced no persuasive reasoning or supporting evidence on why one with ordinary skill in the art would read anything said about the small range from minus 5 [degrees] to plus 15 [degrees] as being equally true for all outward angles without restriction.

At oral argument, counsel for [*23] McMullin was given an opportunity to inform the panel whether any of the original claims accompanying McMullin's involved application as filed referred to an outward angle for each traction tooth or an outer traction surface on each traction tooth that is not limited to a narrow range. McMullin's counsel was able to identify none. McMullin's counsel pointed out, however, that claim 1 as originally filed does not refer to any outward angle and therefore is broad enough to cover an outward angle of any degree. The argument is new and belated and thus dismissed. In any event, even if considered, the argument is misplaced. Claim 1 is so broad that it also covers inward angulation without restriction and zero angulation as well. McMullin's claim 1 as written description is also not commensurate in scope with the later claimed subject matter. It does not show possession by the inventor of the more specific idea expressed in claims 61-81. Whichever way one looks at McMullin's specification which includes the original claims, it does not demonstrate possession of the subject matter later claimed.

Carroll advances an alternative argument that McMullin's specification does not describe the [*24] claim feature that the outward angle or angulation provides lateral stability and enhances traction through the plane of a golf swing. Carroll has not established that McMullin's disclosed invention with the limited angle range does not inherently achieve those results. We agree with McMullin that if a claim feature is inherently present or provided by the structural features described in the specification it is not necessary that it be explicitly described for purposes of satisfying the written description requirement of 35 U.S.C. § 112, first paragraph. The burden is on Carroll as the moving party to demonstrate lack of inherent disclosure. That, it has not done. However, it is not necessary for Carroll to prevail on its alternative argument if its first argument regarding the range of outward angulation is demonstrated to have merit, as is the case here.

For the reasons discussed above, Carroll's Preliminary Motion 2 is **granted**.

McMullin's Preliminary Motion 1

McMullin's Preliminary Motion 1 seeks judgment on patentability over prior art against claims 1-11 of Carroll's involved Patent No. 6,530,162, and claims 77-81 of McMullin's [*25] own involved application. Because we have ruled, in connection with Carroll's Preliminary Motion 2, that the specification of McMullin's involved application does not, under 35 U.S.C. § 112, first paragraph, have written description support for any of McMullin's involved claims 61-81, McMullin is without standing either to contest priority or to attack the patentability of any of Carroll's involved patent claims. In other words, party McMullin has no valid business in this interference to engage in any kind of contest against party Carroll. We regard the question of the existence of a specification that supports at least one interfering claim as a threshold issue the same as the issue of whether an interference-in-fact exists between the parties.

At oral argument, counsel for McMullin cited to *Schulze v. Green*, 136 F.3d 786, 45 USPQ2d 1769 (Fed. Cir. 1998) as authority that we must nonetheless still consider McMullin's attack on the patentability of Carroll's involved claims even if we were to conclude that McMullin's specification is without written description, under 35 U.S.C. § 112, [*26] first paragraph, for any of McMullin's involved claims 61-81. The argument is rejected. That case is not apposite. In *Schulze v. Green*, based on junior party's Green's own preliminary statement it was clear that Green could not prevail on priority. There was not an issue whether junior party Green had possessed the subject matter of an interfering claim. Thus, there was a priority contest and junior party Green simply lost on priority. There was little reason in that case to keep junior party Green, who did not prevail on priority, from attacking the patentability of the senior party's claims, since both parties evidently were claiming the same subject matter and neither was shown to have been without written

description, and therefore possession, of that subject matter under 35 U.S.C. § 112, first paragraph. The situation is entirely different here.

Based on our decision on Carroll's Preliminary Motion 2, McMullin is in the position of an inter-meddlor whose specification cannot support even one claim drawn to the same subject matter of Carroll's claimed invention. Henceforth, McMullin is without standing to proceed with its attack on Carroll's [*27] involved claims. n2

n2 Under 37 CFR § 1.633(i), McMullin in response to Carroll's Preliminary Motion 2 could have attempted to submit alternative claims which do satisfy the written description requirements of 35 U.S.C. § 112, first paragraph, and still interfere with a McMullin claim. No such attempt was made by McMullin.

McMullin's preliminary Motion 1 is **dismissed**.

McMullin's Preliminary Motion 2

McMullin's Preliminary Motion 2 seeks to redefine the subject matter of the count by substituting a new count for the current count. It is contingent upon the granting of McMullin's preliminary Motion 1. Because the contingency has not occurred, the motion is **dismissed**.

McMullin's Preliminary Motion 3

McMullin's Preliminary Motion 3 seeks to redefine the subject matter of the count by substituting a new count for the current count. It is contingent upon the denial of McMullin's Preliminary Motion 1. Because we have ruled, in connection with McMullin's Preliminary Motion 1, that McMullin is without standing either to contest priority or to attack the patentability of any of Carroll's involved patent claims, the motion is [*28] **dismissed**.

Carroll's Preliminary Motion 1

Carroll's Preliminary Motion 1 attacks the priority benefit accorded senior party McMullin upon the declaration of the interference. Because we have, in connection with McMullin's Preliminary Motion 1, ruled that McMullin is without standing to engage in a priority contest with Carroll, Carroll's Preliminary Motion 1 is **dismissed**.

Carroll's Preliminary Motion 3

Carroll's Preliminary Motion 3 seeks to have certain priority benefit accorded to Carroll and is contingent upon the granting of McMullin's Preliminary Motion 2. Because McMullin's Preliminary Motion 2 has been dismissed, Carroll's Preliminary Motion 3 is **dismissed**.

Carroll's Preliminary Motion 4

Carroll's Preliminary Motion 4 seeks to have certain priority benefit accorded to Carroll and is contingent upon the granting of McMullin's Preliminary Motion 3. Because McMullin's Preliminary Motion 3 has been dismissed, Carroll's Preliminary Motion 4 is **dismissed**.

Carroll's Preliminary Motion 5

Carroll's Preliminary Motion 5 seeks to add a reissue application to this interference, contingent upon the granting of McMullin's Preliminary [*29] Motion 1. Because McMullin's Preliminary Motion 1 has been dismissed, Carroll's Preliminary Motion 5 is **dismissed**.

Carroll's Preliminary Motion 6

Carroll's Preliminary Motion 6 seeks to substitute two new counts in place of the current count, and is contingent upon the granting of McMullin's Preliminary Motion 1, Carroll's Preliminary Motion 5, and the denial of Carroll's Preliminary Motion 2. Because McMullin's Preliminary Motion 1 and Carroll's Preliminary Motion 5 have been dismissed and because Carroll's Preliminary Motion 2 has been granted, Carroll's Preliminary Motion 6 is **dismissed**.

Carroll's Preliminary Motion 7

Carroll's Preliminary Motion 7 seeks to be accorded certain priority benefit and is contingent upon the granting of McMullin's Preliminary Motion 1 and Carroll's Preliminary Motion 5. Because McMullin's Preliminary Motion 1 and Carroll's Preliminary Motion 5 have been dismissed, Carroll's Preliminary Motion 7 is **dismissed**.

2004 Pat. App. LEXIS 180, *

Time of Request: May 23, 2005 08:59 AM EDT

Research Information:

Patent Cases from Federal Courts and Administrative Materials
6530162 or 6,530,162

FRANCIS C. CARROLL, Junior Party (Patent Nos. 5,794,367 and 6,530,162) n1 v.
FARIS W. McMULLIN, Senior Party (Application 09/246,325) n2

n1 Patent No. 5,794,367 was filed February 20, 1997. Patent No. 6,530,162 was filed February 23, 1998. With respect to Patent No. 6,530,162, the junior party has been accorded benefit of the earlier filing date of Patent No. 5,794,367. Junior party's real party in interest is Greenkeepers of Delaware, LLC. n2 Filed September 2, 1999. Accorded the benefit of Application 09/209,252, filed December 10, 1998, Application 08/823,901, filed March 2, 1997, and Provisional Application 60/034,328, filed December 20, 1996. The real party in interest is Softspikes, LLC.

Patent Interference No. 105,146

BOARD OF PATENT APPEALS AND INTERFERENCES

2004 Pat. App. LEXIS 180

September 13, 2004, Faxed

[*1]

Before FLEMING, LEE and MEDLEY, Administrative Patent Judges.

COUNSEL:

For junior party Carroll:
202-572-8398 (Fax)
Victor M. Wigman, Esq.
Blank Rome LLP
Watergate 600, 11th Floor,
600 New Hampshire Avenue, N.W.
Washington, D.C. 20037-2485

For senior party McMullin:
312-554-3301 (Fax)
Keith V. Rockey, Esq.
Wallenstein, Wagner & Rockey, Ltd.
311 South Wacker Drive
53rd Floor
Chicago, Illinois 60606-6630

OPINIONBY: LEE

OPINION:

The opinion in support of the decision being entered today is not binding precedent of the Board.

LEE, Administrative Patent Judge.

JUDGMENT- RULE 640

Based on our decision on preliminary motions issued in a concurrent paper, it is now appropriate for entry of judgment. It is

ORDERED that judgment is herein entered against senior party FARIS W. McMULLIN;

FURTHER ORDERED that senior party FARIS W. McMULLIN is not entitled to his claims 61-81 which correspond to the count;

FURTHER ORDERED that if there is a settlement agreement, the parties should note the requirements of 35 U.S.C. § 135(c) and 37 CFR § 1.666; and

FURTHER ORDERED that a copy of this judgment be filed in the respective involved application or patent of the [*2] parties.

US District Court Civil Docket**U.S. District - Pennsylvania Eastern
(Philadelphia)****2:04cv3747****Greenkeepers, Inc et al v. Nike, Inc et al****This case was retrieved from the court on Monday, May 23, 2005**

Date Filed: 08/06/2004
Assigned To: Honorable R Barclay Surrick
Referred To:
Nature of suit: Patent (830)
Cause: Patent Infringement
Lead Docket: None
Other Docket: None
Jurisdiction: Federal Question

Class Code: CLOSED, STANDARD, SUSPENSE
Closed: yes
Statute: 35:271
Jury Demand: Both
Demand Amount: \$0
NOS Description: Patent

Litigants**Attorneys**

Greenkeepers, Inc
Plaintiff

Grant S Palmer
[COR LD NTC]
Blank Rome Comisky & McCauley
One Logan Square
Philadelphia , PA 19103
USA
215-569-5578
Fax: 215-832-5578
Email: Palmer@blankrome.com

Greenkeepers of Delaware, LLC
Plaintiff

Grant S Palmer
[COR LD NTC]
Blank Rome Comisky & McCauley
One Logan Square
Philadelphia , PA 19103
USA
215-569-5578
Fax: 215-832-5578
Email: Palmer@blankrome.com

Nike, Inc
Defendant

Kerry L Timbers
[COR LD NTC]
Bromberg & Sunstein
125 Summer Street
Boston , MA 02110-1618
USA
617-443-9292
Email: Ktimbers@bromsun.com

Michael K Jones
[COR LD NTC]
Woodcock Washburn LLP
One Liberty Place, 46TH Floor
Philadelphia , PA 19103
USA

215-568-3100
Email: Mjones@woodcock.com

Peter J Karol
[COR LD NTC]
Bromberg & Sunstein LLP
125 Summer St
Boston , MA 02110-1618
USA
617-443-9292
Email: Pkarol@bromsun.com

Macneill Engineering
Defendant

Kerry L Timbers
[COR LD NTC]
Bromberg & Sunstein
125 Summer Street
Boston , MA 02110-1618
USA
617-443-9292
Email: Ktimbers@bromsun.com

Michael K Jones
[COR LD NTC]
Woodcock Washburn LLP
One Liberty Place, 46TH Floor
Philadelphia , PA 19103
USA
215-568-3100
Email: Mjones@woodcock.com

Peter J Karol
[COR LD NTC]
Bromberg & Sunstein LLP
125 Summer St
Boston , MA 02110-1618
USA
617-443-9292
Email: Pkarol@bromsun.com

Date	#	Proceeding Text
08/06/2004	1	COMPLAINT against MACNEILL ENGINEERING, NIKE, INC. (Filing fee \$ 150 receipt number 907715.), filed by GREENKEEPERS OF DELAWARE, LLC, GREENKEEPERS, INC..(ss,) Additional attachment(s) added on 10/27/2004 (stb,). (Entered: 08/09/2004)
08/06/2004	--	Summons Issued, Two originals mailed as to MACNEILL ENGINEERING, NIKE, INC.. Forwarded To: Counsel on 8/9/04 (ss,) (Entered: 08/09/2004)
08/06/2004	--	DEMAND for Trial by Jury by GREENKEEPERS OF DELAWARE, LLC, GREENKEEPERS, INC.. (ss,) (Entered: 08/09/2004)
08/06/2004	2	Copy of Form to Commissioner of Patents. (ss,) (Entered: 08/09/2004)
08/17/2004	3	ORDER THAT THIS CASE IS REASSIGNED FROM JUDGE JAN E. DUBOIS TO JUDGE R. BARCLAY SURRICK FOR ALL FURTHER PROCEEDINGS. SIGNED BY CLERK OF COURT MICHAEL E. KUNZ ON 8/17/04. 8/18/04 ENTERED AND COPIES FAXED.(mar,) Modified on 8/18/2004 (mar,). (Entered: 08/18/2004)
12/13/2004	4	APPLICATION by NIKE, INC., MACNEILL ENGINEERING FOR KERRY TIMBERS TO APPEAR PRO HAC VICE, STATEMENT, CERTIFICATE OF SERVICE. (jl,) (Entered: 12/13/2004)
12/15/2004	5	ORDER THAT THE APPLICATION OF KERRY TIMBERS TO PRACTICE PRO HAC VICE IN THIS COURT FOR THE DEFENDANTS IS GRANTED; ETC.. SIGNED BY JUDGE R. BARCLAY SURRICK ON 12/15/04. 12/15/04 ENTERED AND COPIES MAILED AND FAXED.(jl,) (Entered: 12/15/2004)
12/15/2004	6	ANSWER to Complaint together with AFFIRMATIVE DEFENSES, COUNTERCLAIMS, CERTIFICATE OF SERVICE by NIKE, INC., MACNEILL ENGINEERING.(jl,) (Entered: 12/15/2004)
12/22/2004	7	NIKE, INC., MACNEILL ENGINEERING MOTION FOR PARTIAL SUMMARY JUDGMENT OF

- NONINFRINGEMENT BY THE "STINGER II" CLEAT, MEMORANDUM, APPENDIX, DECLARATION, CERTIFICATE OF SERVICE.. (Attachments: # 1 MEMORANDUM# 2 DECLARATION)(jl,) (Entered: 12/22/2004)
- 12/22/2004 8 APPLICATION by NIKE, INC., MACNEILL ENGINEERING FOR PETER KAROL TO APPEAR PRO HAC VICE, STATEMENT, CERTIFICATE OF SERVICE. (jl,) (Entered: 12/23/2004)
- 12/29/2004 9 ORDER THAT THE APPLICATION OF PETER KAROL TO PRACTICE IN THIS COURT PURSUANT TO LOCAL RULE OF CIVIL PROCEDURE 83.5.2 (b) IS GRANTED; ETC.. SIGNED BY JUDGE R. BARCLAY SURRICK ON 12/29/04. 12/29/04 ENTERED AND COPIES MAILED AND FAXED.(jl,) (Entered: 12/29/2004)
- 12/29/2004 10 GREENKEEPERS, INC., GREENKEEPERS OF DELAWARE, LLC's Answer to Defendants' Counterclaims to Plaintiffs' Complaint with Certificate of Service (wgc,) Modified on 12/29/2004 (wgc,). Additional attachment(s) added on 12/30/2004 (wgc,). (Entered: 12/29/2004)
- 01/21/2005 11 GREENKEEPERS, INC., GREENKEEPERS OF DELAWARE, LLC. CROSS MOTION FOR SUMMARY JUDGMENT OF INFRINGEMENT, MEMORANDUM, CERTIFICATE OF SERVICE..(jl,) (Entered: 01/24/2005)
- 02/07/2005 12 RESPONSE in Opposition re 11 MOTION for Summary Judgment of Infringement filed by NIKE, INC., MACNEILL ENGINEERING, Certificate of Service. (KAROL, PETER) Modified on 2/9/2005 (fh,). (Entered: 02/07/2005)
- 02/07/2005 13 Declaration of RICHARD J. LOCKE in Support of NIKE, INC.'S and MACNEILL ENGINEERING COMPANY, INC.'S 11 MOTION for Partial Summary Judgment of Noninfringement by the "STINGER II" Cleat, Certificate of Service. (KAROL, PETER) Modified on 2/9/2005 (fh,). (Entered: 02/07/2005)
- 02/07/2005 14 Declaration of KERRY L. TIMBERS in Support of NIKE, INC.'S and MACNEILL ENGINEERING COMPANY, INC.'S 11 MOTION for Partial Summary Judgment of Noninfringement by the "STINGER II" Cleat. (KAROL, PETER) Modified on 2/9/2005 (fh,). (Entered: 02/07/2005)
- 02/07/2005 15 Supplemental Declaration of JEFFREY M. DOW in Support of NIKE, INC.'S and MACNEILL ENGINEERING COMPANY, INC.'S 11 MOTION for Partial Summary Judgment on Noninfringement by the "STINGER II" Cleat. (KAROL, PETER) Modified on 2/9/2005 (fh,). (Entered: 02/07/2005)
- 02/07/2005 16 Supplemental Appendix of Exhibits in Support of NIKE, INC.'S and MACNEILL ENGINEERING COMPANY, INC.'S 11 MOTION for Partial Summary Judgment of Noninfringement by the "STINGER II" Cleat. (Attachments: # 1 Exhibit 13# 2 Exhibit 14-16# 3 Exhibit 17-19# 4 Exhibit 20# 5 Exhibit 21# 6 Exhibit 22# 7 Exhibit 23)(KAROL, PETER) Modified on 2/9/2005 (fh,). (Entered: 02/07/2005)
- 02/18/2005 17 GREENKEEPERS, INC., GREENKEEPERS OF DELAWARE, LLC SURREPLY MEMORANDUM IN OPPOSITION TO NIKE'S AND MACNEIL ENGINEERING'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT BY THE "STINGER II" CLEAT AND REPLY MEMORANDUM IN SUPPORT OF GREENKEEPERS' CROSS-MOTION FOR SUMMARY JUDGMENT OF INFRINGEMENT, CERTIFICATE OF SERVICE. (jl,) (Entered: 02/22/2005)
- 03/28/2005 18 MOTION to Stay Unopposed filed by NIKE, INC., MACNEILL ENGINEERING.Memorandum, Certificate of Counsel and Certificate of Service. (Attachments: # 1 Text of Proposed Order) (TIMBERS, KERRY) (Entered: 03/28/2005)
- 04/05/2005 19 ORDER THAT THE UNOPPOSED MOTION TO STAY THIS ACTION IS GRANTED. THIS ACTION IS STAYED AND THE CLERK OF COURT IS DIRECTED TO PLACE THIS CASE IN CIVIL SUSPENSE PENDING THE CONCLUSION OF THE REISSUE PROCEEDINGS CONCERNING U.S. PAT. NO. 6,530,162; ETC.. SIGNED BY JUDGE R. BARCLAY SURRICK ON 4/5/05. 4/5/05 ENTERED AND E-MAILED.(jl,) (Entered: 04/05/2005)